

*34
Cancelled.*

distributing the local advertisements to the user television equipment, wherein the local advertisements are specific to a particular geographic region; using the interactive television program guide to display the local advertisements; and providing a user with an opportunity to use the interactive television program guide to select the local advertisements.

Remarks

Claims 1-132 are pending in this application. Applicants have cancelled claims 47-64, and 118-132 without prejudice.

Summary of the Office Action

The Examiner indicates that a restriction is required under 35 U.S.C. § 121. The Examiner asserts that applicants are claiming patentably distinct inventions defined by:

Group I: Claims 1-46, and 75-117;

Group II: Claims 47-62, and 118-130; and

Group III: Claims 63, 64, 131, and 132.

Claims 1, 2, 6, 24, 25, 29, and 75 are rejected under 35 U.S.C. § 102(e) as being anticipated by

Hendricks et al. U.S. Patent 5,734,853 (hereinafter "Hendricks").

Claims 1-5, 12-15, 18, 20-28, 35-38, 41, 43-46, 75-77, 85, 86, 89, 91-99, 106-109, 112, and 114-117 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr et al. U.S. Patent 6,209,129 (hereinafter "Carr") in view of Klosterman et al. U.S. Patent 5,940,073 (hereinafter "Klosterman").

Claims 6-8, 10, 29-31, 33, 78-80, 82, 100-102, and 104 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Berezowski et al. U.S. Patent 6,075,551 (hereinafter Berezowski).

Claims 9, 11, 32, 34, 81, 83, 103, and 105 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Chen et al. U.S. Patent 5,917,830 (hereinafter Chen).

Claims 19, 42, 90, and 113 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Klosterman et al. U.S. Patent 6,078,348 (hereinafter "the '348 patent").

Claims 16, 39, 87, and 110 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of

Klosterman, and further in view of Kikinis U.S. Patent 5,929,849 (hereinafter Kikinis).

Claims 17, 40, 88, and 111 are rejected under 35 U.S.C. § 103(a) as being unpatenable over Carr in view of Klosterman, and further in view of Kikinis and Berezowski et al. U.S. 6,064,376 (hereinafter "the '376 patent").

Applicants' Reply to the Restriction Requirement

In a telephone conversation between the undersigned and Examiner Son P. Huynh on November 14, 2002, a provisional election was made without traverse to prosecute Group I, claims 1-46, and 75-117. Applicants hereby affirm the election of Group I; claims 1-46, and 75-117 without traverse.

Claims 47-64, and 118-132 have been withdrawn from further consideration under 37 CFR § 1.142(b) as being drawn to a non-elected invention. Applicants reserve the right to pursue the subject-matter of the non-elected claims in one or more subsequent continuing applications that claim priority and benefit from this application.

Applicants' Reply to the Rejection under 35 U.S.C. § 102(e)

Claims 1, 2, 6, 24, 25, 29, and 75 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hendricks.

Applicants have amended claims 1, 24, 75, and 95 to more particularly define the invention. No new matter has been added and the amendments are fully supported and justified by the specification. Applicants respectfully traverse this rejection.

Applicants' invention, as defined by independent claims 1, 24, 75, and 95, relates to systems, a method, and a machine readable medium for distributing local advertisements to user television equipment, wherein the local advertisements are specific to a particular geographic region, using the interactive television program guide to display the local advertisements, and providing a user with an opportunity to use the interactive television program guide to select the local advertisements (e.g., to obtain additional information about an advertised product or service or to order an advertised product or service).

Hendricks refers to a television program delivery system in which a menu interface is provided to enable users to access television programming.

The Examiner contends that Hendricks inherently shows each feature of applicants' independent claim 1. Applicants respectfully submit that this contention is unfounded. Hendricks fails to show or suggest an interactive television program guide that uses the

interactive television program guide to display the local advertisements that are specific to a particular geographic region and provides a user with an opportunity to use the interactive television program guide to select the local advertisements. Rather, Hendricks discloses that advertisements and television programming are inserted into packets, which are distributed to users. If any local advertisements are displayed, they are displayed in conjunction with regular television programming - not by an interactive television program guide (e.g., in distinct advertisement regions).

Applicants respectfully submit that the Examiner does not point to anything in Hendricks that would serve as an anticipation of applicants' claimed feature of allowing a user to use an interactive television program guide to select local advertisements. The Examiner indicates that Hendricks discloses allowing a user to "access a desired program by clicking [an] associated region on the menu" (Office Action, Page 5). Whether or not this is what Hendricks discloses is irrelevant. Accessing a program has nothing to do with allowing the user to select an advertisement in the context of applicant's invention.

Accordingly, applicants respectfully submit that independent claims 1, 24, 75, and 95 are not anticipated by

Hendricks. Applicants also submit that claims 2-23, 26-46, 76-94, and 96-117 are not anticipated by Hendricks because they depend from claims 1, 24, 75, and 95.

Applicants' Reply to the
Rejection under 35 U.S.C. § 103(a)

Claims 1-5, 12-15, 18, 20-28, 35-38, 41, 43-46, 75-77, 85, 86, 89, 91-99, 106-109, 112, and 114-117 are rejected under 35 U.S.C. § 103(a) as being unpatenatable over Carr in view of Klosterman. Applicants respectfully traverse this rejection.

Carr "relates to passive television program guides, and more particularly, to techniques for providing local information with such passive television program guides" (column 1, lines 7-11). As defined in Carr, "a passive program guide system ... provides users with program guide information, promotional information, and regional advertising without requiring that the user have any special television equipment other than a standard television" (column 2, lines 39-43). That is, passive program guides provide information to the user without enabling a user to interact with the guide.

Klosterman refers to an interactive program schedule guide with information regions for displaying, among other things, additional information such as

advertisements or promotions. Klosterman provides interactive features by enabling a user to interact with either the program guide, information regions, or both.

The Examiner concedes that Carr does not show a system in which an interactive television program guide is implemented. The Examiner further concedes that Carr does not show displaying local advertisements and using an interactive television program guide to provide a user with an opportunity to select the local advertisements. The Examiner contends that these features are disclosed by Klosterman.

The Examiner attempts to combine Carr and Klosterman by contending that it would be obvious to one of ordinary skill in the art to modify Carr to incorporate an interactive television program guide. Contrary to the Examiner's contention, there is no prior art suggestion or motivation to combine Carr and Klosterman because "the proposed modification or combination of the prior art would change the principle of operation of the prior art invention [(Carr)]" (MPEP, § 2143.01, p. 2100-125, Eighth ed.). Here, the Examiner is modifying Carr, a passive television program guide, to include interactive features of an interactive television program guide. Modifying a passive television program guide to be an interactive

television guide changes the principle operation of Carr. Therefore, because there is no suggestion or motivation to modify or combine the teachings of Carr and Klosterman, the *prima facie* case of obviousness is not met.

In fact, the references teach away from being combined. Carr specifically states: "[p]assive television program guides are not capable of providing the user with any interactive features" (column 1, lines 23-25).

In view of the foregoing, claims 1, 24, 75, and 95 are patentable over Carr and Klosterman. Claims 2-23, which depend from independent claim 1, claims 25-46, which depend from independent claim 24, claims 76-94, which depend from independent claim 75, and claims 96-117, which depend from independent claim 95 are patentable because claims 1, 24, 75, and 95 are patentable.

Applicants' Reply to the Remaining Rejections under 35 U.S.C. § 103(a)

Claims 6-8, 10, 29-31, 33, 78-80, 82, 100-102, and 104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carr in view of Klosterman, and further in view of Berezowski.

Claims 9, 11, 32, 34, 81, 83, 103, and 105 are rejected under 35 U.S.C. § 103(a) as being unpatentable

over Carr in view of Klosterman, and further in view of Chen.

Claims 19, 42, 90, and 113 are rejected under 35 U.S.C. § 103(a) as being unpatenatable over Carr in view of Klosterman, and further in view of the '348 patent.

Claims 16, 39, 87, and 110 are rejected under 35 U.S.C. § 103(a) as being unpatenatable over Carr in view of Klosterman, and further in view of Kikinis.

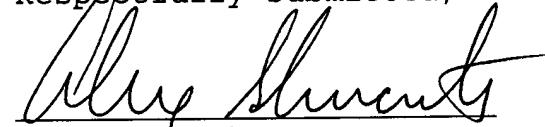
Claims 17, 40, 88, and 111 are rejected under 35 U.S.C. § 103(a) as being unpatenatable over Carr in view of Klosterman, and further in view of Kikinis and the '376 patent.

Because applicants have demonstrated in the foregoing that claims 1, 24, 75, and 95 are allowable, dependent claims 6-11, 16, 17, 19, 29-34, 39, 40, 42, 78-83, 87, 88, 90, 100-105, 110, 111, and 113 are also allowable.

Conclusion

The foregoing demonstrates that claims 1-46 and 75-117 are allowable. Applicants respectfully submit that this patent application is in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully Submitted,



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Appendix

Please amend claims 1, 24, 75, and 95 as follows.

1. (Twice Amended) A system in which local advertisements are distributed to user television equipment on which an interactive television program guide is implemented, comprising:

means for distributing local advertisements to the user television equipment [as part of a data stream], wherein the local advertisements are specific to a [subset of interactive television program guide users] particular geographic region;

[means for using the interactive television program guide to process the data stream to extract the local advertisements;]

means for using the interactive television program guide to display the local advertisements; and

means for providing a user with an opportunity to use the interactive television program guide to select the local advertisements.

24. (Twice Amended) A method for using a system in which local advertisements are distributed to user television equipment on which an interactive television program guide is implemented, comprising the steps of:

distributing the local advertisements to the user television equipment [as part of a data stream], wherein [said] the local advertisements are specific to a [subset of interactive television program guide users] particular geographic region;

[using the interactive television program guide to process the data stream to extract the local advertisements;]

using the interactive television program guide to display the local advertisements; and

providing a user with an opportunity to use the interactive television program guide to select the local advertisements.

75. (Amended) A system in which local advertisements are displayed on user television equipment, the system comprising:

a television distribution facility that distributes local advertisements to the user television equipment [as part of a data stream], wherein the local advertisements are specific to a [subset of interactive television program guide users] particular geographic region;

an interactive television program guide that is implemented on the user television equipment, wherein the interactive television program guide [processes the data stream to extract the local advertisements, and wherein interactive television program guide] displays the local advertisements; and

a control interface that provides a user with an opportunity to interact with the interactive television program guide to select the local advertisements.

95. (Amended) A machine readable medium encoded with machine-readable instructions for use in a system in which local advertisements are distributed to user television equipment on which an interactive television program guide is implemented, the machine-readable instructions comprising:

distributing the local advertisements to the user television equipment [as part of a data stream], wherein [said] the local advertisements are specific to a [subset of interactive television program guide users] particular geographic region;

[using the interactive television program guide to process the data stream to extract the local advertisements;]

using the interactive television program guide to display the local advertisements; and providing a user with an opportunity to use the interactive television program guide to select the local advertisements.